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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
9-78773-097	05/10/97	FEYGIN	I 301.0001

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EXAMINER

LE, L

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 09/11/98

**Please find below and/or attached an Office communication concerning this application or
proceeding.**

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/872,097

Applicant(s)
Feygin et al.

Examiner
Long V. Le

Group Art Unit
1743



☒ Responsive to communication(s) filed on Aug 24, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-65 is/are pending in the application.

Of the above, claim(s) 44-46 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-43 and 47-65 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 44-46 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. Applicants' addition of claims 47-65 is acknowledged and has been entered.

Election/Restriction

2. Applicant's election with traverse of group I in Paper No. 4 is acknowledged. The traversal is on the ground(s) that the restriction requirement does not present a serious burden to the examiner in search and examine all of the present claims; and the claims show subject matter overlap. This is not found persuasive because the record set forth in the previous restriction requirement clearly indicates that the delineated inventions are in fact patentably distinct each from the other or independent each from the other.

The requirement is still deemed proper and is therefore made FINAL.

3. The added claims 47-65 draw to the same subject matter of group I, therefore, they are included in group I for examination.

Specification

4. The amendment filed August 20, 1998 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: claims 49-61 recite new structural limitations of the reaction vessel, i.e., means for preventing solid phase material from escaping from the reaction vessel, first and second frits, the glass material and its strengthening feature, the specific angle of the second outlet, the threaded end, etc. Further, claims 62-65 recite the outer hollow shell. These newly added limitations do not have support from the original specification.

Applicant is required to cancel the new matter in the reply to this Office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 49-65 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter recited in claims 51-65 do not have support from the original specification (see the discussion in the objection to the specification above).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 2, 4-6, 8, 9, 23, 24, 26-28 and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Gleave et al. (USP 5,660,727).

Gleave et al. anticipate the instant claims by teaching a reaction tool comprising a reaction vessel 101, a reaction vessel support 23, an injection port 106 and an evacuation port 109, each includes a pressure seal 116, and injection and evacuation

fittings 161 and 164 for matingly engaging the injection and evacuation ports (figures 4, 6 and 10).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

11. Claims 3, 7, 10-16, 25, 29-34, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleave et al. (USP 5,660,727) in view of Panetz et al. (USP 5,585,068).

Gleave et al. reference has been discussed above which fails to recite that the top and bottom support plates form a carousel. Panetz et al. teach an apparatus for automatically separating a compound from liquid specimens including a carousel support plate 70 having an injection port 75 and fitting 72 for engaging with a reaction vessel 50. Such an arrangement would provide a smaller, compact sample preparation apparatus which can prepare samples for further analysis on either a batch or continuous basis (figures 1, 2, 13, 14 and column 2, lines 4-19).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the apparatus of Gleave et al. with a carousel support plate, as taught by Panetz et al., in order to provide a smaller, compact sample preparation apparatus which can prepare samples for further analysis on either a batch or continuous basis.

12. Claims 17-22, 29, 35-40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleave et al. (USP 5,660,727) in view of Averette (USP 5,147,551).

Gleave et al. reference further fails to recite a stirrer motor and a magnet positioned adjacent a sidewall of the reaction vessel. Averette teaches a reaction tool having a stirring motor 223 with a magnet 225 attached its shaft for stirring fluids inside a reaction vessel 250.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the reaction tool of Gleave et al. with a magnet stirrer, as taught by Averette, in order to mix fluids inside the reaction vessel.

With respect to the snap on heater, one of ordinary skill in the art would have found it obvious to separate the heater 208 of Gleave et al. from the system since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

13. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleave et al. (USP 5,660,727) in view of Panetz et al. (USP 5,585,068) as applied to claim 34 above, and further in view of Averette (USP 5,147,551) for the reasons discussed in the previous paragraph.

14. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gleave et al. (USP 5,660,727) in view of Park et al. (USP 3,715,190).

Gleave et al. further fail to recite that the reaction vessel comprising an addition inlet. However, such a multiple inlet reaction vessel is considered conventional in the art, see Park et al. Park et al. teach a reaction vessel for the solid phase peptide synthesis having a plurality of inlets at one end thereof in order to separately insert a solvent and a reagent inside the vessel (figures 1 and 4, and the abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the reaction vessel of Gleave et al. with an additional inlet in order to separately insert a solvent or a reagent inside the reaction vessel.


Conclusion

15. No claims are allowed.

16. References: Brunfeldt et al., Neimark et al., Kohr '488, Winter et al., Staats, III et al., Kohr '435, Astle, and Hayashi et al. are cited as art of interest for the teachings of automated synthesizing apparatus.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Long V. Le whose telephone number is (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.



Long V. Le
Primary Patent Examiner, Group Art Unit 1743
September 8, 1998.